REMARKS

Claims 1 and 5-25 are pending. Claims 26-35 have been cancelled without prejudice to their reinstatement in this or a later-filed application and without prejudice to the remaining claims in the instant application.[1] Claims 1 and 17 the only pending independent claims. All pending claims stand rejected in view of official notice of various wine tasting procedures ("Official Notice") and various references.

Applicants respectfully submit that all pending claims are allowable over the alleged prior art of record for three reasons. First, the Office Action, citing neither an Examiner affidavit nor sufficient documentary evidence, has improperly relied on Official Notice. Second, even if the Official Notice is proper, neither it, nor the references cited against independent claims 1 and 17, teach or suggest each and every claim limitation recited therein. Third and finally, the Office Action fails to provide sufficient motivation for the asserted combinations relied upon in rejecting the pending claims.

Official Notice

The Office Action, at pages 2-5, takes official notice of various wine tasting procedures. Applicants respectfully submit that the Official Notice is improper for the following reasons:

- The facts within the Official Notice asserted to be well-known or to be common knowledge in the art are not capable of instant and unquestionable demonstration and no affidavit or supporting reference was provided;
- The web materials attached to the Notice of References Cited (the "Web References"), to the extent they represent documentary evidence the Office Action intended to rely upon, do not support the assertions made in the Official Notice; and
- Failure of the Office Action to allege documentary support for the Official Notice is improper during a final action.

These points are addressed *seriatim* hereinafter.

The Official Notice is improper because "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable

[1] Although the Office Action has rejected claims 26-35 based on obviousness, Applicants do not concede the rejection is proper. Applicants merely cancelled these claims in an effort to place the instant application in condition for allowance. Accordingly, Applicants reserve the right to challenge the appropriateness of these rejections in this or a later-filed case.

demonstration as being well-known." *Id.*, *citing*, *In re Alhlert*, 424 F.2d 1088 (C.C.P.A. 1970). Since Applicants do not consider the assertions made in connection with the Official Notice to be well-known or capable of instant and unquestionable demonstration, pursuant to 37 C.F.R. § 1.104(d)(2), Applicants requests that the Examiner provide either a reference or an affidavit in support of the Official Notice. By way of example, "testing wines and then recording information such as its origin, aroma, year of make for qualifying a wine" is not capable of instant and unquestionable demonstration. Likewise, the nexus between the recording step and expert testing of unknown wines that the Official Notice seeks to draw is not capable of instant and unquestionable demonstration.

To the extent the Official Notice is based upon the Web References attached to the Notice of References cited (there is no such indication), Applicants respectfully submit that it is still improper. First, neither of the two Web References support the assertions made in the Official Notice. For example, neither Web Reference teaches that "an expert who has compiled or at least has [sic] made records of such data in preliminary tasting process is then allowed to taste unknown wines and answer questions regarding character to the unknown wine." Thus, the documentary evidence (if any) simply does not support the Official Notice. Second, there is no indication that the Web References were available at the time Applicants filed the instant application. Indeed, both Web References are undated. The only indication of date, which appears on Wine Tasting 101, reveals 2003 – after the filing date of the instant application.

Finally, the Office Action's failure to allege the existence of any documentary evidence in support of the Official Notice is improper during a final office action:

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While official notice may be relied on, these circumstances should be rare when an application is under final rejection.

See M.P.E.P. § 2144.03(A). For this reason alone, Applicant requests withdrawal of the Official Notice or of the finality of the rejection.

35 U.S.C. § 102/103 Rejections

Claims 1 and 5-7 stand rejected as being anticipated under 35 U.S.C. § 102 by Official Notice of any wine tasting procedure. Applicants respectfully request withdrawal of

this rejection because it is improper on its face and it does not include the limitations recited by independent claim 1.

Indeed, "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." M.P.E.P. § 2144.03(A), *citing*, *In re* Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001) (noting "the Board cannot simply reach conclusions based on its own understanding or experience . . . Rather, the Board must point to some concrete evidence in the record in support of these findings"). (Emphasis added.) The absence of evidence in support of the assertions made in the Office Notice defeats the rejection of claims 1 and 5-16.

Even assuming, however, that the Official Notice is proper, Applicants respectfully submit that such Official Notice does not meet all of the limitations recited by independent claim 1. The Official Notice does not even hint at a method for playing a game, where the method steps are each carried out during the game, as recited by independent claim 1. For example, the Official Notice does not teach or suggest "a method for playing a game" comprising "preliminarily tasting each of at least two different beverage samples during the game." Further, the Official Notice does not teach or suggest "answering at least one question about the [recorded] information," as recited by independent claim 1. Rather the Official Notice states "questions may be answered regarding character to the unknown wine." There is no indication that these questions relate to recorded information generated during a preliminary tasting step during the game, as recited by independent claim 1. For these reasons, independent claim 1 and dependent claims 6-16 are allowable over the Official Notice.

Claims 1, 5-19 and 24-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 5,918,882 to Truong (hereinafter "Truong") in view of Official Notice of any wine tasting procedure. Yet, neither Truong nor the Official Notice teach or suggest the step of "answering at least one question about the [recorded] information," as recited by independent claim 1. Similarly, Truong and Official Notice also fail to teach or suggest "answering at least one question about the at least one of the name, year, and region of the unidentified beverage," as recited by independent claim 17. As mentioned above, the Official Notice simply does not assert that these steps are or were well-known in the art, particularly in the context of a method for playing a game, such as the method claimed herein. Moreover, Applicants respectfully traverse the Office Action's unsupported characterization of Truong as it relates to preliminary tasting. Truong simply does not teach or suggest a preliminary

tasting step. For these reasons, independent claim 1 and dependent claims and 17, as well as dependent claims 5-16 and 18-25 are allowable over Truong and Official Notice.

Claims 1, 5-19, 24-32 and 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Truong in view of Official Notice and further in view of U.S. Pat. No. 4,733,863 to Novotny (hereinafter "Novotny"). Applicant respectfully submits that Novotny does not cure the above-identified deficiencies in Truong and the Official Notice – namely, Novotny does not teach or suggest "answering at least one question about the [recorded] information," as recited by independent claim 1 or "answering at least one question about the at least one of the name, year, and region of the unidentified beverage," as recited by independent claim 17. For these reasons, independent claim 1 and dependent claims and 17, as well as dependent claims 5-16 and 18-25 are allowable over Truong and Official Notice.

Claims 20-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Truong in view of Official Notice, Novotny and further in view of U.S. Pat. No. 4,529205 to Bowker ("Bowker"). Claims 33-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Truong, Official Notice and Novotny. Since dependent claims 20-23 depend from an allowable base or intervening claim, these dependent claims are allowable over the art of record. Claims 33-34 have been cancelled.

Lack of Motivation For The Asserted Combinations

Not only do the cited references fail to teach or suggest Applicants' invention, the asserted combinations are improper. The Action relies on impermissible hindsight in its combination of references and the proposed modifications render the prior art invention being modified unsatisfactory for its intended purpose.

With respect to the combination of Truong and Official Notice, although the statement on page 3 of the Action that, "in order to make the game [of Truong] more interesting, it would have been obvious to allow preliminary tasting of wines before being put to test/competition" may or may not have been the motivation driving the inventors in the instant case, the only potential teaching for such motivation is Applicants' patent application. Using Applicants' own invention to supply the motivation for combining references is inappropriate. *In re* Mills, 916 F.2d 680 (Fed. Cir. 1990) (stating "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination").

Once again, independent claim 1 and dependent claims and 17, as well as dependent claims 5-16 and 18-25 are allowable over both combinations of Truong with Official Notice.

CONCLUSION

Given the foregoing, Applicants respectfully submit that independent claims 1 and 17 are allowable over the rejections of record. Since dependent claims 5-16 and 18-25 depend from an allowable base or intervening claims, these claims are also allowable. Favorable action is earnestly solicited at an early date.

If, in the Examiner's opinion, a telephone interview would be helpful, Applicants' representative invites the Examiner to call him directly at the telephone number below.

Respectfully submitted,

December 6, 2004

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450. Valeria Rodriguez